

**Response Under 37 CFR § 1.116 –
Expedited Procedure – Examining Group 2157**

If the Examiner does not withdraw the final status of the Office Action, Applicants submit that this response does not raise new issues in the application. It is submitted that the present response places the application in condition for allowance or, at least, presents the application in better form for appeal. Entry of the present response is therefore respectfully requested.

REMARKS

In the Office Action, the Examiner:

- rejected claim 1 under 35 U.S.C. § 112, second paragraph as being indefinite; and
- rejected claims 1-34 under 35 U.S.C. § 103(a) as being unpatentable over Nielsen (U.S. 5,948,054) in view of Dworkin et al. (U.S. 6,026,148).

Rejection under 35 U.S.C. §112, second paragraph

As noted above, the Examiner rejected claim 1 under 35 U.S.C. § 112, second paragraph as being indefinite specifically because it was unclear to the Examiner *"whether the 'an item of information that indicates timeliness and quantity of answer' in line 7 of the claim is the same 'item of information of each expert' in line 11 of the. (sic) For examination purposes they are the same item of information."* As the Examiner correctly interpreted this recitation for Examination of the Amendment dated March 9, 2004, these are the identical elements. Applicants have amended claim 1 to clarify this element as previously correctly interpreted by the Examiner as follows:

an expert ranking database for maintaining a list of experts in one or more categories along with *an item of information indicative of timeliness of an expert in providing answers and quality of answers provided by an expert;*

an expert set determinator for extracting a set of experts in a particular category from the expert ranking database based on *the item of*

Response Under 37 CFR § 1.116 –**Expedited Procedure - Examining Group 2157**

information indicative of timeliness of each expert in providing answers
and quality of answers provided by each expert;

No new matter has been added. The Applicants respectfully submit that the Examiner's rejection of claim 1 under 35 U.S.C. §112, second paragraph has been overcome and should be withdrawn, which withdrawal is respectfully requested.

Rejection under 35 U.S.C. §103(a) over Nielsen and Dworkin

As noted above, the Examiner rejected claims 1-34 under 35 U.S.C. § 103(a) as being unpatentable over Nielsen (U.S. 5,948,054) in view of Dworkin et al. (U.S. 6,026,148). The Applicants respectfully traverse this rejection and respectfully request entry of this amendment to place the application in a better form for appeal on the merits.

The Examiner correctly states on page 4 of the Office Action that "... Nielson does not teach the selection of expert based on timeliness of an expert in providing answers" and goes on to combine Nielsen with Dworkin.¹ Further the Examiner on page 6 of the Office Action points to Dworkin for disclosing "... a system where the user is given the opportunity to direct a question to an expert of his or her choice and that choice could be based on anything, time matching of words, subject, expert qualification, etc (col. 7, lines 6-27)." (Emphasis Added). The cited portion of Dworkin at col. 7, lines 6-27 is reproduced below for convenience with emphasis added:

In the example given above, there was only one expert respondent at one time, each respondent being "on duty" for a predetermined period of time. As mentioned above, there could instead be more than one expert available at the same time. The user could be given the opportunity to direct a question to an expert of his or her choice. Alternatively, the system can be programmed to direct the question to a particular expert respondent. One way of choosing the expert is to analyze the key words

¹ Applicants make no comment whether such combination is even proper.

Response Under 37 CFR § 1.116 –**Expedited Procedure - Examining Group 2157**

appearing in a question, and comparing those key words with the key words appearing in a biography of the expert. The greater the number of matches between the two sets of words, the greater the likelihood that the expert is appropriate to respond to the question. In another alternative, the system could ask the user to indicate a subject, from a menu of possible subjects, and the system would then choose an expert according to the subject selected. The invention is not limited by the manner of choosing an expert, however, and much simpler and more unintelligent means of making the choice could be used instead, within the scope of the invention. For example, a question could be assigned at random to any available expert respondent.

The Applicants respectfully request where, with particularity, in Dworkin the “timeliness of an expert in providing answers” is explicitly described, taught or even suggested. More simply, where is the phrase suggesting timeliness of the response in Dworkin?

Therefore, because the Nielsen reference taken alone and/or in view of Dworkin makes no mention of the timeliness of an expert in responding to questions posed, amended independent claims 1, 5, 16, 20 and 31 distinguish over the Nielsen reference taken alone and/or in view of Dworkin. The Nielsen reference does not teach, anticipate, or suggest all of the recited elements of independent claims 1, 5, 16, 20 and 31. Therefore, the Examiner’s rejection should be withdrawn and it is respectfully submitted that amended independent claims 1, 5, 16, 20 and 31 are in a condition for allowance.

Continuing further, when there is no suggestion or teaching in the prior art for “*indicative of timeliness of an expert in providing answers*” the suggestion can not come from the Applicant’s own specification. The Federal Circuit has repeatedly warned against using the Applicant’s disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference Nielsen taken alone and/or in view of Dworkin does not even suggest,

ARC9-1999-0242

13

09/607,289

**Response Under 37 CFR § 1.116 –
Expedited Procedure - Examining Group 2157**

teach or mention timeliness.

Recently, the Federal Circuit again took up the identical question of Obviousness in combining references in the case *In re Sang Su Lee*, No. 00-1158 (January 18, 2002). In this case, the Board of Patent Appeals rejected all of Applicant's pending claims as obvious under § 103. The Federal Circuit vacated and remanded. Citing two prior art references, the Board stated that a person of ordinary skill in the art would have been motivated to combine the references based on "common knowledge" and "common sense," but it did not present any specific source or evidence in the art that would have otherwise suggested the combination. The Federal Circuit held that the Board's rejection of a need for any specific hint or suggestion in the art to combine the references was both legal error and arbitrary agency action subject to being set aside by the court under the Administrative Procedure Act (APA). Accordingly, with the suggestion or motivation found in Nielsen taken alone and/or in view of Dworkin, the Examiner has failed to properly establish a prima facie case of obviousness of the invention as a "whole." The Applicants submit the present invention distinguishes over Nielsen taken alone and/or in view of Dworkin for at least this reason as well.

In regards to the Examiner's rejections under paragraphs 5-8, 10-19, 21-24, 26-34 in the Office Action directed to claims 3-6, 8-18, 20-22, 25-30 and 31-34, where the Examiner positively states that neither Nielsen taken alone and/or in view of Dworkin teach a claim element and goes on to state, without support, "[H]owever, it would have been obvious for one having ordinary skill in the art at the time of the invention to include limitations to achieve..." a stated purpose xyz, where xyz represents the current claim language being cited. The Applicants respectfully request that the Examiner put on the record the prior art that teaches the timeliness of each expert answer. Further, under MPEP § 2144.03, where the Examiner takes official notice on facts outside the record and "when a rejection is based on facts within the personal knowledge" of the Examiner the Applicant may require an affidavit from the Examiner to support such personal knowledge. The Applicants respectfully request such an affidavit from the Examiner to put these facts on the record for each of these unsupported statements

ARC9-1999-0242

14

09/607,289

Response Under 37 CFR § 1.116 –**Expedited Procedure - Examining Group 2157**

regarding claims 5-7, 11-12, 14-22, 26-34. Stated differently, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Nielsen taken alone and/or In view of Dworkin is silent on this desirability of ranking experts because of timeliness.

Further, because independent claims 1, 5, 16, 20 and 31 distinguish over the Nielsen reference taken alone and/or in view of Dworkin, dependent claims 2-4, 6-15, 17-19, 21-30 and 32-34, also distinguish over the Nielsen reference. Therefore, the Nielsen reference taken alone and/or in view of Dworkin does not teach, anticipate or suggest all of the recited elements of dependent claims 2-4, 6-15, 17-19, 21-30 and 32-34. Therefore, the Examiner's rejection should be withdrawn and it is respectfully submitted that dependent claims 2-4, 6-15, 17-19, 21-30 and 32-34 are in a condition for allowance.

CONCLUSION

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is

ARC9-1999-0242

15

09/607,289

Response Under 37 CFR § 1.116 –**Expedited Procedure - Examining Group 2157**

knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully submitted.

Dated: July 19, 2004

By: 

Jon Gibbons (Reg. No. 37,133)
Attorney for Applicants
Fleit, Kain, Gibbons, Gutman & Bongini P.L.
One Boca Commerce Center, Suite 111
551 N.W. 77th Street
Boca Raton, FL 33487
Tel. (561) 989-9811
Fax (561) 989-9812

PLEASE Direct All Correspondence to Customer Number 23334

ARC9-1999-0242

16

09/607,289